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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,069	05/13/1999	SHIGETAKA TANAKA	2271/59262	8608

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EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/29/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/317,069

Applicant(s)

TANAKA, SHIGETAKA

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This communication is responsive to amendment filed on May 28, 2002.

Applicant adds new claims 7-9.

Response to Applicant's Remarks

1. Applicant remarks that primary reference, Malik fails to teach the novel use of optional frames recited in claims.

It is noted that claims 1-2, 4-6 are rejected over Malik in view of Yamada. Malik teaches the use of optional frames but fails to teach the step of canceling performance of the facsimile communications operations when the identification sent from the calling facsimile machine does not correspond with the identification information prestored in the memory. From the rejection, it was commonly known in the art that if the identification sent from the calling facsimile does not match with the identification information prestored in the memory, the facsimile communications between the two terminals is terminated or disconnected. Yamada is combined with Malik to support that well known in the prior art.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik (US Patent No. 5,991,290) in view of Yamada (US Patent No. 5,872,641).

Concerning claims 1, 4, 7, Malik discloses a facsimile communication method for performing a group 3 facsimile communication operation using an optional frame signal in a calling number display service mode comprising the steps of providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames; receiving a call for a facsimile communications operation using an optional frame and identification information from a calling facsimile machine; verifying the identification information sent from the calling facsimile machine with the identification information prestored in the memory; executing the facsimile communications operation using the optional frame when the identification information sent from the calling facsimile machine corresponds to the identification information prestored in the memory (Figs. 1, 2, 5, 6; col. 3, lines 31-51; col. 5, lines 3-28; col. 6, lines 46-68; col. 7, line 66 – col. 8, line 24).

For claims 1, 4, Malik does not teach the step of canceling performance of the facsimile communications operation when the identification information sent from the calling facsimile machine does not correspond with the identification information prestored in the memory. However, it was commonly known in the art that if the identification sent from the calling facsimile does not match with the identification information prestored in the memory (or the identification sent from the calling facsimile is improper), the facsimile communications between the two terminals is terminated or disconnected. Yamada supports that well known in the prior art by teaching a communication apparatus having improved group 3 facsimile subaddress

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communication. In Fig.4, subaddress frame(s) SUB is(are) transmitted to the system controller 2 (S7). The system controller 2 then checks whether or not the transferred subaddress frame(s) SUB comprises a proper one. Depending on the properness/improperness check result, the communication controller 13 determines whether or not to receive the relevant image information (S8). If the subaddress is proper or it is determined to receive the image information, the reception procedure continues. If the subaddress is improper or it is determined not to receive, the relevant establish communication is immediately cut (S10) and the current process is terminated (col. 8, line 21 – col. 9, line 14). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teaching of cutting the communication line and ending the receiving process in Yamada to Malik since both of them teach the determination of the proper/improper of the identification information in a facsimile communication having subaddress communication function.

For claim 7, Malik fails to teach that if the identification information does not correspond with the identification prestored in the memory, standard facsimile operations that do not use the optional frame are performed while the facsimile operations that would use the optional frame are canceled. Yamamoto further teaches that when the subaddress (identification information) is not pre-registered or does not correspond with the information prestored in the memory (Fig.8), “the subaddress(es), set in the subaddress frame(s) SUB together with the apparatus type information, is(are) registered as the ordinary transmission destination(s) relevant to the received and stored image information, in T5-4 in Fig.8.” (col. 11, line 66 – col. 12, line 9).

Concerning claim 2, Malik further teaches the identification information comprises subscriber identification each contained in a frame TSI to be generated by each of the plurality of different facsimile machines and the identification information received in the receiving step is a subscriber identification contained in a frame TSI generated by the calling facsimile machine (Figs 5; col. 7, lines 1-65).

Concerning claims 5, 6, Malik in view of Yamada discloses a facsimile apparatus (Fig.2) comprising a memory means (295), a modem (250), a controller means (205) for performing the steps discussed in claim 1 above.

1. Claims 3, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik in view of Yamada as applied to claim 1 above, and further in view of Saito (US Patent No. 5,692,036).

Concerning claim 3, Malik further teaches that the optional frames are in conformance with the recommendation T-30 of ITU-T (col. 5, lines 20-23)..

Malik fails to teach that the optional frames include SUB, SEP, and PWD. However, it was commonly known in the art that the setting of SUB/SEP/PWD is of the ITU-T Recommendation T.30. Saito support that well known in the art by disclosing a facsimile apparatus having auto calling function wherein the facsimile facilitates the setting of SUB/SEP/PWD of the ITU-T Recommendation T.30 (Figs.3A-B; Abstract; col. 2, line 43 – col. 3, line 43). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teaching of the setting of SUB/SEP/PWD of the ITU-T Recommendation T.30 in Saito to the optional frames in conformance with the recommendation

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T.30 of ITU-T in Malik because both of them teach the subaddress optional frame in conformance with the recommendation T.30 of ITU-T.

Concerning claims 8-9, Malik fails to teach that the memory means stores a table of identification information identifying facsimile machines capable of operating with optional frames. Saito further teaches a table of identification information identifying facsimile machines capable of operation with optional frames (Fig.2). It would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teaching of the table in Saito to the table in Malik since both of them teach a table containing the addresses of terminals capable of operating with optional frames.

Conclusion

4. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



Madeleine AV Nguyen
Primary Examiner
Art Unit 2622

AV
August 13, 2002